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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,503	12/11/2000	Megan Burns	20-EB-2098/624226.288	4306

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EXAMINER

STERRETT, JONATHAN G

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/734,503	Applicant(s) BURNS ET AL.	
	Examiner Jonathan G. Sterrett	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Final Office Action is responsive to applicant's amendment filed January 7, 2005. Applicant's amendment of January 7, 2005 amended claim 16; and added claims 29-32. Currently claims 1-32 are pending.

Response to Amendment

2. Applicant's arguments filed on January 7, 2005 with respect to claims 1-32 have been considered and are considered moot in light of new grounds of rejection. The objection to Claim 25 has been withdrawn.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Claim 13 states "application specific information related to the terrain over which the prospective purchaser anticipates use of the vehicle. There is no support in the provisional application detailing terrain related limitations.

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Claims 15-19, 30 and 32 reference locomotives and railroad specific limitations in the claims. There is no support in the provisional application detailing railroad or locomotive specific limitations.

For the reasons discussed above, **benefit of the earlier filing date of provisional application 60/190680 is denied for Claims 15-19, 30 and 32**

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 USC. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 5, 6 and 9-11** are rejected under 35 USC. 103(a) as being unpatentable over Kotler.

Kotler, Philip, Marketing Management, "Marketing Concepts and Tools 19-3" 8th edition, 1994, p.504.

Regarding Claim 1, Kotler teaches

providing access to information related to a product to a prospective purchaser of the product,

paragraph 2 line 1-4, the company in this example developing new products "Y" and "Z" would be providing access to information related to a product to a prospective purchaser of the product. In this example, the prospective purchaser is a potential customer of the company.

receiving application specific information related to prospective use of the product from the prospective purchaser;

paragraph 2 and 3, in order to do the comparison between the reference product "X" and the other two products, it would be necessary for the company to receive application specific information related to prospective use of the product from the prospective purchase. In this way, the postpurchase costs for new product "Y" and "Z" would be calculated – maintenance and operations –

producing data responsive to the application specific information from the prospective purchaser and indicative of a calculated value of the product to the prospective purchaser arising from a prospective purchase and use of the product; and

Chart "Postpurchase costs (maintenance and operations) illustrates data produced that is responsive to the application specific information from the prospective purchaser and indicative of a calculated value arising from the prospective purchase and use of the product.

In this case, Kotler teaches that a company selling a product would be providing comparison costs to a prospective purchaser arising from the prospective purchase and use of the product. In this case the prospective purchaser owns "Reference Product X".

Kotler's calculated value of \$1000 would be the economic value to the customer, where there is an indifference point. In this case, it is a total life cycle cost of \$1,000.

communicating the data to the prospective purchaser.

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Paragraph 1 line 9-11, comparison of a product's total cost against the product a customer is currently using would entail the above information being communicated to the prospective purchaser.

Kotler does not teach the above **via the information network**.

However automating what is a proven and known sales process in industrial marketing by conveying information via an information network is not invention.

Further it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity that has accomplished the same result. In re Venner, 120 USPQ 192.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kotler, regarding receiving application specific information, producing data responsive to said information and communicating the data to the prospective purchaser, to include automating the process via the information network, because the resulting system would have benefited from being made faster, easier to use and more efficient.

Regarding **Claim 2**, Kotler teaches:

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calculating a return on investment parameter responsive to the application specific information; and communicating the return on investment parameter to the prospective purchaser.

Paragraph 3 line 1-3, new product "Y" would provide a \$300 savings to a prospective purchaser. The savings is calculated from the application specific information, in this case maintenance and operations costs, and comprises a return on investment parameter responsive to the application specific information.

Regarding **Claim 5**, Kotler teaches:

Paragraph 1 line 3-11, using total costs to calculate a lifecycle cost figure to enable comparisons between competing product offerings and a current product in use by the customer. His method is a technique to enable industrial customers to see the value of various products where the value is not always recognized by the customer.

Kotler does not teach:

querying the prospective purchaser via the information network regarding the prospective purchaser's interest in additional information regarding the product.

Official notice is taken that it is old and well known in the art of marketing to query the prospective purchaser regarding their interest in additional information regarding the product. Examples of this include reader survey cards in various

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industrial magazines whereby readers can circle numbers associated with various product advertisements to receive additional information on a particular product.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Kotler regarding communicating product benefits associated with life cycle costs with querying the prospective purchaser regarding their interest in additional information regarding the product, because it would provide a convenient and easy way for customers to obtain additional product information.

Kotler and reader service cards do not teach providing additional information over a network.

However automating what is an existing proven and known sales process in industrial marketing by conveying information via an information network is not invention.

Further it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity that has accomplished the same result. In re Venner, 120 USPQ 192.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kotler, regarding querying and providing

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additional information to customers, to include automating the process via the information network, because the resulting system would have benefited from being made faster, easier to use and more efficient.

Regarding **Claim 6**, Kotler teaches:

querying the prospective purchaser regarding the prospective purchaser's desire to make a purchase.

Paragraph 1 line 1-3, offers are made to a customer regarding the sale of a product to the customer, this would include querying the prospective purchase regarding their desire to make a purchase.

Kotler does not teach the above:

via the information network.

Further it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity that has accomplished the same result. In re Venner, 120 USPQ 192.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kotler, regarding querying customers as to their desire to make a purchase, to include automating the process via the information network, because the resulting system would have benefited from being made faster, easier to use and more efficient.

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Regarding **Claim 9**, Kotler teaches:

wherein the prospective purchaser is an operator of an off-highway mining vehicle,

paragraph 1 line 6-7, industrial companies, including those wherein the prospective purchasers are operators of an off-highway mining vehicle, could use the technique outlined by Kotler.

the product is an upgrade to the vehicle,

paragraph 4 line 1-2, new product Z has more features or performance characteristics than product X or Y.

and the application specific information comprises mine specific information including a total system operating cost without the upgrade,

Figure at bottom of page contains "maintenance and operation" postpurchase costs. Since off-highway mining equipment falls into the category of industrial products sold by industrial companies as taught by Kotler, then the "maintenance and operation" costs in Kotler's analysis would have to consist of mine specific information since it relates to a specific industrial product being marketed.

and further comprising:

calculating a total system operation cost with the upgrade;

Figure at the bottom of the page contains "Life Cycle Costs" which are a total system operation cost.

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subtracting the total system operating cost with the upgrade from the total system operating cost without the upgrade to obtain the total system operation savings; and

Paragraph 3 line 3, in Kotler's example, a total system operation savings would be \$300.

communicating the total system operation savings to the operator.

Paragraph 1 line 1-9, Kotler's description of how to market to a customer by highlighting total system operation savings, would include communicating the total system operation savings to the operator.

Regarding **Claim 10**, Kotler teaches the limitations above except for at least two products.

Paragraph 2 line 1-3, Products Y and Z are two products being compared to an existing product in use by the customer, Product X.

Regarding **Claim 11**, Kotler teaches:

using the data to identify a recommended product to be purchased by the prospective purchaser; and communicating the recommendation to the prospective purchaser.

Kotler teaches recommending products Y and Z to replace product X based on a comparison of costs (paragraph 3 line 1-8).

Kotler teaches communicating the recommendations to the purchaser to aid them in making the purchase (paragraph 1 line 1-9). Kotler teaches that the

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recommendation must be made because customers do not always recognize the value of a company's product offering.

6. **Claims 3, 7, 8** are rejected under 35 USC. 103(a) as being unpatentable over Kotler in view of Maggioncalda US 6,012,044.

Regarding **Claim 3**, Kotler teaches:

Providing a graphic that illustrates various levels of cost savings that is responsive to the magnitude of those savings (see chart at bottom of page).

Kotler does not teach:

further comprising providing the data to the prospective purchaser via a graphical user interface using a color scheme responsive to a level of the return on investment parameter.

Maggioncalda teaches:

further comprising providing the data to the prospective purchaser via a graphical user interface using a color scheme responsive to a level of the return on investment parameter.

Column 13 line 37-40 & line 62-67, the use of icons which incorporate color (sky, clouds, sun and sun rays) provide data to a prospective purchase of investment products, said data is in the form of a graphical user interface using a color scheme responsive to a level of return on investment.

Column 13 line 62-67, Maggioncalda teaches that other metaphors may be used to convey this type of information – it is old and well known in the art to

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use colors representing traffics lights, i.e. red, green and yellow to convey information.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kotler regarding industrial selling which highlights cost savings to a prospective purchaser to use a graphical user interface which highlights various return on investment parameters using colors responsive to the various ROI parameters, as taught by Maggioncalda, because it would provide a well understood intuitive way to highlight the financial result of various business decisions.

Regarding **Claim 7**, Kotler teaches:

Receiving application specific information, as discussed above, for highlighting the cost benefits associated with a new product purchase and use.

Kotler does not teach:

providing a graphical user interface for receiving information from a prospective purchaser's data processor via the information network.

Maggioncalda teaches:

providing a graphical user interface for receiving information from a prospective purchaser's data processor via the information network.

Figure 4 & Figure 5b, Graphical user interfaces for receiving information from a prospective purchaser's data processor via the information network.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kotler, regarding receiving application specific information from a prospective purchaser, with receiving information from a graphical user interface, as taught by Maggioncalda, because it would make receiving the application specific information faster, easier to use and more efficient.

Regarding **Claim 8**, Kotler teaches:

Providing data to the prospective purchaser in a graphical means.

Kotler does not teach:

providing the data to the prospective purchaser via the graphical user interface in a print-ready format.

Official Notice is taken that it is old and well known in the art of web page development to provide data in a print ready format. Many web pages contain the capability to click an icon or link to provide the contents of the webpage in a print ready format.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kotler and Maggioncalda, as discussed above, to include providing the data in a print ready format, because it would make it easier and more convenient for the user to print out the data on a printer.

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7. **Claim 4** is rejected under 35 USC. 103(a) as being unpatentable over Kotler in view of Woodside.

Woodside, Arch, "Network Anatomy of Industrial Marketing and Purchasing of New Manufacturing Technologies", 1993, Journal of Business and Industrial Marketing, v9n3, pp.52-63.

Regarding **Claim 4**, Kotler teaches:

Paragraph 1 line 3-11, using total costs to calculate a lifecycle cost figure to enable comparisons between competing product offerings and a current product in use by the customer.

Kotler does not teach:

saving at least a portion of the application specific information; and using the saved portion of the application specific information in a further product sales opportunity.

Woodside teaches:

saving at least a portion of the application specific information; and using the saved portion of the application specific information in a further product sales opportunity.

Page 57 paragraph 4 and page 58 paragraph 1, information gathered from the customer, including application specific information, is saved and used in a further product sales opportunity. The information gathering by the consulting engineer is saved and used in a further product sales opportunity, namely the proposal described in paragraph 2 of page 57.

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Woodside teaches that proactive industrial marketing plays a key role in convincing customers to switch to new products (page 56 paragraph 6 line 1-7) and that this kind of marketing happens over a series of interactions with the customer (see figures 1-6 on pages 57 and 58).

It would have been obvious to one of ordinary skill at the time of the invention to modify the teachings of Kotler, regarding obtaining application specific information from a customer, with saving at least a portion of the application specific information for use in a further product sales opportunity, as taught by Woodfield, because it would enable and make efficient the ongoing dialog between customers and marketing necessary for the adoption of new products by customers.

Claims 12-32 recite limitations already addressed by the limitations of Claims 1-11 above, therefore the same rejection applies.

Conclusion

8. **THIS ACTION IS NONFINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PRNewswire, "Interpose introduces Product Expert, the first sales tool automating technology ROI calculations", November 6, 1995, p1106ne003.

This article details the web-enabled ability for prospective purchasers to perform product configurations online and to conduct ROI calculations.

The following series of webpages from web.archive.org detail this application:

Web.archive.org, interpose.com, July 10, 1997, "TCO Research and Tools", pp.1-5.

Web.archive.org, interpose.com, July 10, 1997, "About C/S Solution Advisor", p.1.

Caterpillar webpages from 1996-1999 detail various product offerings and information from their website.

Web.archive.org, cat.com, "Site menu", "Engine Division Home Page", "On-Highway Truck Engines", "Specification Sheet Library", "On Highway Trucks", "Electrical Power Generation", 1996-1999, various pages.

Dolan, Thomas, "Wooing prospects and winning the next deal", 1995, Computer Reseller News, pS28(1), n650.

Chadwell-Hatfield, Patricia, "Financial Criteria, capital budgeting techniques, and risk analysis of manufacturing firms", Winter 1996-1997, vol 13, issue 1, pp.1-15.

Sweat, Jeff, "What's Your ROI?", August 24, 1998, InformationWeek, www.informationweek.com/697/97iuroi.htm, pp.1-3.

Kelly, Thomas, "Database Marketing and Sales Force Automation, a Powerful Combination!", Dec 6, 1998, pp.1-2. This article can be found at web.archive.org/web/19981206192231/www.qssolutions.com/pub1.htm.

While a copy of it is not provided in this office action, the following article is recommended: Forbis, John; Mehta, Nitin, "Economic Value to the Customer", McKinsey Staff Paper, February 1979, pp.1-10.

US 6,236,975 by Boe discloses a system and method for profiling customers for targeted marketing.

US 6,741, 967 by Wu discloses a full service research bureau and test center method and apparatus.

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US 6,018,731 by Bertrand discloses a goal based system utilizing a spreadsheet and table based architecture.

US 6,621,505 by Beauchamp discloses a dynamic enterprise computing system and method.

US 6,122,648 by Roderick discloses a method apparatus and system for improved content management and delivery.

US 6,115,690 by Wong discloses an integrated business to business web commerce and business automation system.

US 6,671,818 by Mikurak discloses standard object formats in a network based supply chain.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 703-305-0550. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 4/10/2005



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